

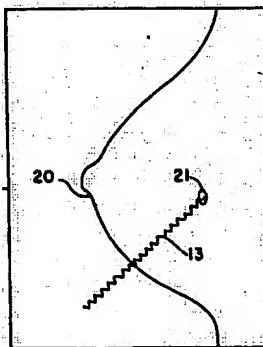
REMARKS

Reconsideration of the rejections set forth in the Office Action mailed April 21, 2006, is respectfully requested. Claims 46-49, 54, and 61 have been canceled without prejudice. Claims 50 and 60 have been amended to include the subject matter from dependent claims 54 and 61, respectively. Therefore, no new matter was added with these amendments. Claims 50-51, 55-60, 62, and 65-67 remain pending in this application.

Art Rejections

Claim 46-51, 55, 56-60, and 65-67 were rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Campbell et al. (USP Re. 34,936) in view of Kaldany (USP 5,562,613) and Shiber (USP 5,195,540).

Applicants respectfully assert that this combination of references would not result in deployment of the marker such that “*no part of the marker element extends outside the body,*” as required by the claims. As seen in Fig. 6 of Shiber reproduced below, spiral wire 13 clearly extends outside the body.



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Indeed, Shiber requires that the marker is left “sticking out of the patient’s body.” (See Col. 1, lines 26-27; see also Col. 2, lines 33-39 “The proximal section of the spiral wire *which is left sticking out of the patient's body* can be bent and taped to the patient's body, to prevent it from unscrewing and drifting from the lesion and to reduce discomfort to the patient. Since the spiral wire is also visible to the naked eye it serves to readily locate the lesion later on, for example during surgery.” (emphasis added)) Therefore, the cited art teaches away from the asserted combination.

Additionally, Applicants respectfully assert that there is no motivation to combine the references. The marking device of Shiber consists of a spiral wire 13 that is “slid and rotated over a guiding needle like a cork screw.” (See Col. 2, lines 27-28). Similar to the device of Rank, discussed in the Amendment and Response filed on April 12, 2005, the marker is deployed by rotating the marker. The marking device of Shiber would not be operable for deployment through a side exit port of Campbell in view of Kaldany because it could not be released through a side port because it is coiled around a guiding needle, both of which extend from the lesion to a point outside of the body.

Information Disclosure Statement

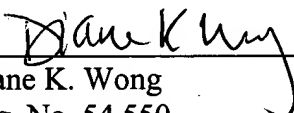
In reviewing the signed Form PTO/SB/08A’s returned by the Examiner, Applicants note that the Examiner has not returned the PTO/SB08A mailed on **March 31, 2003; July 15, 2004; July 26, 2004; and September 30, 2005** (duplicate copies have been attached for the

convenience of the Examiner). Applicants respectfully request that the Examiner review these references and return initialed Forms PTO/SB/08A to the Applicants.

For all the foregoing reasons, Applicants assert the claims are in condition for allowance. Favorable action on the merits of the claims is therefore earnestly solicited. If any issues remain, please contact Applicant's undersigned representative at (949) 760-9600. The Commissioner is hereby authorized to charge any additional fees that may be required to Deposit Account No. 50-2862.

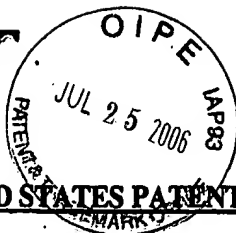
Respectfully submitted,
O'MELVENY & MYERS LLP

Dated: July 21, 2006

By: 
Diane K. Wong
Reg. No. 54,550
Attorneys for Applicants

JCK/DKW/cp

O'Melveny & Myers LLP
610 Newport Center Drive, Suite 1700
Newport Beach, CA 92660-6429
(949) 760-9600



Docket No. END-777

UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants **Seth A. Foerster et al.**

Serial No. **09/954,646**

Art Unit: **3764**

Filed : **September 18, 2001**

Examiner: **Benjamin Koo**

For : **METHOD AND DEVICES FOR
DEFINING AND MARKING TISSUE**

Assistant Commissioner for Patents
Washington, D.C. 20231

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March 31, 2003
(Date of Deposit)

Patricia A. Deffinger

Name of person signing the Certificate

Patricia A. Deffinger
(Signature)

March 31, 2003
(Date of Signature)

INFORMATION DISCLOSURE STATEMENT

Dear Sir:

Pursuant to 37 C.F.R. §1.56 and in accordance with 37 C.F.R. §§1.97-1.98, information relating to the above-identified application is hereby disclosed. Inclusion of information in this statement is not to be construed as an admission that this information is material as that term is defined in 37 C.F.R. §1.56(b).

Applicant(s) reserve(s) the right to establish the patentability of the claimed invention over any of the information provided herewith, and/or to prove that this information may not be prior art, and/or to prove that this information may not be enabling for the teachings purportedly offered.

This statement should not be construed as a representation that a search has been made, or that information more material to the examination of the present patent application does not exist.

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This Information Disclosure Statement is being filed after filing of a Request for Continued Examination and prior to receipt of an Office Action responding to the RCE.

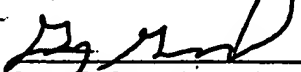
☒ Copies of references listed on the attached PTO Form 1449 were previously cited by or submitted to the Patent and Trademark Office in one or both of prior applications 08/858,389 and 09/776,125 to which this application claims priority, and so copies are not included with this paper.

☒ There are no listed references which are not in the English language.

☐ The relevance of those listed references which are not in the English language is as follows:

Please charge any deficiency or credit any overpayment to Deposit Account No. 10-0750/END-777/GSG. This form is submitted in triplicate.

Respectfully submitted



Gerry S. Gressel

Reg. No. 34,342

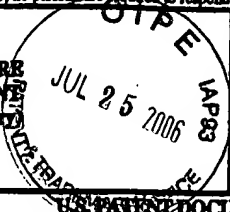
Attorney for Applicants

Johnson & Johnson
One Johnson & Johnson Plaza
New Brunswick, NJ 08933-7003
(513) 337-3535
Dated: March 31, 2003

Substitute for form 1449A/PTO

**INFORMATION DISCLOSURE
STATEMENT BY APPLICANT**
(use as many sheets as necessary)

Sheet 1 of 2



| | |
|------------------------|--------------------|
| Application Number | 09/954,646 |
| Filing Date | September 18, 2001 |
| First Named Inventor | Seth A. Foerster |
| Group Art Unit | 3764 |
| Examiner Name | |
| Attorney Docket Number | END-777 |

U.S. PATENT DOCUMENTS

| Examiner Initials | Cite No. ¹ | U.S. Patent Document | | Name of Patentee or Applicant of Cited Document | Date of Publication of Cited Document mm-dd-yyyy | Pages, Columns, Lines, where relevant passages or relevant figures appear |
|----------------------|--------------------------|----------------------|--------------------------------------|--|--|---|
| | | Number | Kind Code ² (if known) | | | |
| | | 4,086,914 | | Moore, Edwin Bailey | 05/78 | ALL |
| | | 4,402,308 | | Scott, Walter P. | 09/83 | ALL |
| | | 4,709,703 | | Lazarow et al. | 12/87 | ALL |
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| | | 5,358,474 | | Kaldany, Antoine | 10/94 | ALL |
| | | 5,487,392 | | Haaga, John R. | 01/96 | ALL |
| | | 5,526,822 | | Burbank et al. | 06/96 | ALL |
| | | 5,538,010 | | Darr et al. | 07/96 | ALL |
| | | 5,562,613 | | Kaldany, Antoine | 10/96 | ALL |
| | | 5,649,547 | | Ritchart et al. | 07/97 | ALL |
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| | | 5,496,314 | | Eggers | 03/96 | ALL |
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| | | 6,228,055 | B1 | Foerster et al. | 05/08/01 | ALL |

FOREIGN PATENT DOCUMENTS

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|----------------------|--------------------------|-------------------------|---------------------|------------------------|--|--|--|----------------|
| | | Office ³ | Number ⁴ | Kind Code ⁵ | | | | |
| | | | | | | | ALL | |

Examiner
SignatureDate
Considered

OTHER PRIOR ART - NON PATENT LITERATURE DOCUMENTS

| Examiner's Initials* | Cite No. ¹ | Include name of the author (in CAPITOL LETTERS), title of the article (when appropriate), title of the item (book, magazine, journal, serial, symposium, catalog, etc.), date, page(s), volume-issue number(s), publisher, city and/or country where published | T ² |
|-------------------------|--------------------------|--|----------------|
| | | S.S. Kramer et al; "Permanent Radiopaque Marker Technique for the Study of Pharyngeal Swallowing in Dogs"; Dysphagia vol., pp. 163-167 (1987). | |
| | | Homer et al; "The Geopgraphic Cluster of Microcalcifications of the Breast" Surgery, Gynecology & Obstetrics, DCC. (1985). | |
| | | Finan et al; "Intrasternal Radiotherapy for Early Stage Vaginal Cancer"; The Journal of Reproductive Medicine, Vol. 38, No. 3 Mar. 1993 | |

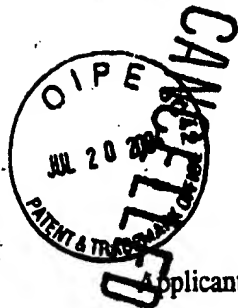
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1 Unique citation designation number. 2 See attached Kinds of U.S. Patent Documents. 3 Enter Office that issued the document, by the two-letter code (WIPO Standard ST.3). 4 For Japanese patent documents, the indication of the year of the reign of the Emperor must precede the serial number of the patent document. 5 Kind of document by the appropriate symbols as indicated on the document under WIPO Standard ST. 16 if possible. 6 Applicant is to place a check mark here if English language Translation is attached.

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47
41
Docket No. END-777

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants : Seth A. Forester et al.
Serial No. : 09/954,646 Art Unit:
Filed : September Examiner:
For : METHODS AND DEVICES FOR DEFINING
AND MARKING TISSUE

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Kimberly Moses 7-15-04
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Assistant Commissioner for Patents
Washington, D.C. 20231

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INFORMATION DISCLOSURE STATEMENT

Dear Sir:

Pursuant to 37 C.F.R. §1.56 and in accordance with 37 C.F.R. §§1.97-1.98, information relating to the above-identified application is hereby disclosed. Inclusion of information in this statement is not to be construed as an admission that this information is material as that term is defined in 37 C.F.R. §1.56(b).

Applicant(s) reserve(s) the right to establish the patentability of the claimed invention over any of the information provided herewith, and/or to prove that this information may not be prior art, and/or to prove that this information may not be enabling for the teachings purportedly offered.

This statement should not be construed as a representation that a search has been made, or that information more material to the examination of the present patent application does not exist.

[] In accordance with §1.97(b), since this Information Disclosure Statement is being filed either within three months of the filing date of the above-identified national

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application (other than a continued prosecution application under §1.53(d)), within three months of the date of entry into the national stage of the above identified application as set forth in §1.491, or before the mailing date of a first Office Action on the merits of the above-identified application, or before the mailing date of a first Office Action after the filing of a request for continued examination under §1.114, no additional fee is required.

☐ In accordance with §1.129(a), this Information Disclosure Statement is being filed in connection with ☐ the first or ☐ second After Final Submission, therefore:

☐ Statement in Accordance with §1.97(e) (attached); or

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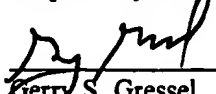
☐ Statement in Accordance with §1.97(e) (attached); or

☒ Please charge Deposit Account No. 10-0750/END-777/GSG the fee of \$180.00 as set forth in §1.17(p).

☒ Copies of references listed on the attached Form PTO-1449 are not included under 37CFR 1.98(d) where the references have been cited in US Patent Application 09/776,125 to which the application claims priority.

Please charge any deficiency or credit any overpayment to Deposit Account No. 10-0750/GSG/END-777.

Respectfully submitted,


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Attorney for Applicants

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New Brunswick, NJ 08933
Phone (513) 337-3535
Date: July 15, 2004



PTO/SB/08A (08-00)

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DISCLOSURE
STATEMENT BY APPLICANT**

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Sheet 1 of 2

| | |
|------------------------|-------------------------|
| Application Number | 09/954,646 |
| Filing Date | September 18, 2001 |
| First Named Inventor | Seth A. Foerster et al. |
| Group Art Unit | 3737 |
| Examiner Name | E. Mantis Mercader |
| Attorney Docket Number | END -777 |

U.S. PATENT DOCUMENTS

| Examiner Initials | Cite No. ¹ | U.S. Patent Document | | Name of Patentee or Applicant of Cited Document | Date of Publication of Cited Document mm-dd-yyyy | Pages, Columns, Lines, where relevant passages or relevant figures appear |
|----------------------|--------------------------|----------------------|--------------------------------------|--|--|---|
| | | Number | Kind Code ² (if known) | | | |
| | | 3,592,185 | | Ephraim, et al. | 07-13-1971 | ALL |
| | | 4,087,791 | | Lemberger | 05-02-1978 | ALL |
| | | 4,541,438 | | Parker, et al. | 09-17-1985 | ALL |
| | | 4,735,210 | | Goldenberg | 04-05-1988 | ALL |
| | | 4,735,798 | | Gordon | 04-05-1988 | ALL |
| | | 5,041,826 | | Milheiser | 08-20-1991 | ALL |
| | | 5,101,827 | | Goldenberg | 04-07-1992 | ALL |
| | | 5,114,703 | | Wolf, et al. | 05-19-1992 | ALL |
| | | 5,127,918 | | Spencer, et al. | 07-07-1992 | ALL |
| | | 5,300,120 | | Knapp, et al. | 04-05-1994 | ALL |
| | | 5,433,751 | | Christel, et al. | 07-18-1995 | ALL |
| | | 5,437,279 | | Gray | 08-01-1995 | ALL |
| | | 5,470,308 | | Edwards, et al. | 11-28-1995 | ALL |
| | | 5,482,040 | | Martin, Jr. | 01-09-1996 | ALL |
| | | 5,496,536 | | Wolf | 03-05-1996 | ALL |
| | | 5,514,379 | | Weissleder, et al. | 05-07-1996 | ALL |
| | | 5,555,885 | | Chance | 09-17-1996 | ALL |
| | | 5,579,766 | | Gray | 12-03-1996 | ALL |
| | | 5,582,172 | | Papisov, et al. | 12-10-1996 | ALL |

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|----------------------|--------------------------|-------------------------|---------------------|------------------------|--|--|--|----------------|
| | | Office ³ | Number ⁴ | Kind Code ⁵ | | | | |
| | | WO | 98/09247 | A1 | Cothren, et al. | 03-05-1998 | ALL | |
| | | WO | 98/52617 | A2 | McIntire, et al. | 11-26-1998 | ALL | |

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|-----------------------|--------------------|
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| Group Art Unit | 3737 |
| Examiner Name | E. Mantis Mercader |
| Attorney Docket Number | END -777 |

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| | | 4,541,438 | | Parker, et al. | 09-17-1985 | ALL |
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| | | 4,735,798 | | Gordon | 04-05-1988 | ALL |
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| | | 5,482,040 | | Martin, Jr. | 01-09-1996 | ALL |
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| | | 5,555,885 | | Chance | 09-17-1996 | ALL |
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| | | 5,582,172 | | Papisov, et al. | 12-10-1996 | ALL |

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Sheet 2 of 2

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| First Named Inventor | Seth A. Foerster et al. |
| Group Art Unit | 3737 |
| Examiner Name | E. Mantis Mercader |
| Attorney Docket Number | END -777 |

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| | | 5,595,177 | | Mena, et al. | 01-21-1997 | ALL |
| | | 5,674,288 | | Knapp, et al. | 10-07-1997 | ALL |
| | | 5,697,902 | | Goldenberg | 12-16-1997 | ALL |
| | | 5,716,407 | | Knapp, et al. | 02-10-1998 | ALL |
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| | | 5,732,704 | | Thurston, et al. | 03-31-1998 | ALL |
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| | | 5,776,094 | | Goldenberg | 07-07-1998 | ALL |
| | | 5,803,913 | | Khalkhall, et al. | 09-08-1998 | ALL |
| | | 5,810,808 | | Ritchart, et al. | 09-22-1998 | ALL |
| | | 5,855,609 | | Knapp | 01-05-1999 | ALL |
| | | 5,857,463 | | Thurston, et al. | 01-12-1999 | ALL |
| | | 5,868,778 | | Gershony, et al. | 02-09-1999 | ALL |
| | | 5,895,640 | | Khalkhall | 04-20-1999 | ALL |
| | | 5,899,865 | | Chance | 05-04-1999 | ALL |
| | | 5,913,857 | | Ritchart, et al. | 06-22-1999 | ALL |
| | | 5,970,986 | | Bolz, et al. | 10-26-1999 | ALL |
| | | 5,977,431 | | Knapp, et al. | 11-02-1999 | ALL |
| | | | | | | |

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| | | Office ³ | Number ⁴ | Kind Code ⁵ | | | | |
| | | WO | 99/25248 | A1 | Carroll | 05-27-1999 | | |
| | | WO | 99/46284 | A2 | Rajotte, et al. | 09-16-1999 | | |

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¹ Unique citation designation number. ² See attached Kinds of U.S. Patent Documents. ³ Enter Office that issued the document, by the two-letter code (WIPO Standard ST.3). ⁴ For Japanese patent documents, the indication of the year of the reign of the Emperor must precede the serial number of the patent document. ⁵ Kind of document by the appropriate symbols as indicated on the document under WIPO Standard ST. 16 if possible. ⁶ Applicant is to place a check mark here if English language Translation is attached.

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INFORMATION DISCLOSURE
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Sheet 1 of 3

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|------------------------|-------------------------|
| Application Number | 09/954,646 |
| Filing Date | September 18, 2001 |
| First Named Inventor | Seth A. Foerster et al. |
| Group Art Unit | 3737 |
| Examiner Name | E. Mantis Mercader |
| Attorney Docket Number | END -777 |

U.S. PATENT DOCUMENTS

| Examiner Initials | Cite No. ¹ | U.S. Patent Document | | Name of Patentee or Applicant of Cited Document | Date of Publication of Cited Document mm-dd-yyyy | Pages, Columns, Lines, where relevant passages or relevant figures appear |
|--------------------|-----------------------|-----------------------------|----|---|--|---|
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| | Filing Date | September 18, 2001 |
| | First Named Inventor | Seth A. Foerster et al. |
| | Group Art Unit | 3737 |
| | Examiner Name | E. Mantis Mercader |
| | Attorney Docket Number | END -777 |

Sheet 2 of 3

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| Examiner's Initials* | Cite No. ¹ | Include name of the author (in CAPITOL LETTERS), title of the article (when appropriate), title of the item (book, magazine, journal, serial, symposium, catalog, etc.), date, page(s), volume-issue number(s), publisher, city and/or country where published | T ² |
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| Examiner's Initials* | Cite No. ¹ | Include name of the author (in CAPITOL LETTERS), title of the article (when appropriate), title of the item (book, magazine, journal, serial, symposium, catalog, etc.), date, page(s), volume-issue number(s), publisher, city and/or country where published | T ² | | |
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Docket No. END-777

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants : Seth A. Forester et al.

Serial No. : 09/954,646

Art Unit: 3737

Filed : September 18, 2001

Examiner: Eleni Mercader

For : METHODS AND DEVICES FOR DEFINING
AND MARKING TISSUE

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Kimberly Moses 7-26-04
Kimberly M. Moses Date

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Alexandria, VA 22313-1450

SUPPLEMENTAL INFORMATION DISCLOSURE STATEMENT

Dear Sir:

Pursuant to 37 C.F.R. §1.56 and in accordance with 37 C.F.R. §§1.97-1.98, information relating to the above-identified application is hereby disclosed. Inclusion of information in this statement is not to be construed as an admission that this information is material as that term is defined in 37 C.F.R. §1.56(b).

Applicant(s) reserve(s) the right to establish the patentability of the claimed invention over any of the information provided herewith, and/or to prove that this information may not be prior art, and/or to prove that this information may not be enabling for the teachings purportedly offered.

This statement should not be construed as a representation that a search has been made, or that information more material to the examination of the present patent application does not exist.

[] In accordance with §1.97(b), since this Information Disclosure Statement is being filed either within three months of the filing date of the above-identified national application (other than a continued prosecution application under §1.53(d)), within three months of the date of entry into the national stage of the above identified application as set

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identified application, or before the mailing date of a first Office Action after the filing of a request for continued examination under §1.114, no additional fee is required.

[X] In accordance with §1.97(c), this Information Disclosure Statement is being filed after the period set forth in §1.97(b) above but before the mailing date of either a Final Action under §1.113 or a Notice of Allowance under §1.311, or an action that otherwise closes prosecution and that it is accompanied by one of:

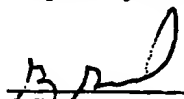
[] Statement in Accordance with §1.97(e) (attached); or

[X] Please charge Deposit Account No.10-0750/END-777/GSG the fee of \$180.00 as set forth in §1.17(p).

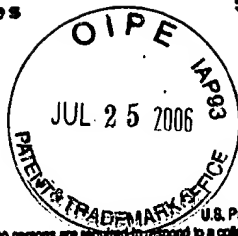
[x] Copies of references listed on the attached Form PTO-1449 are not included under 37 CFR 1.98(d) where the references have been cited in US Patent Application 09/776,125 to which this application claims priority.

Please charge any deficiency or credit any overpayment to Deposit Account No. 10-0750/GSG/END-777.

Respectfully submitted,


Gerry S. Gressel
Reg. No. 34,342
Attorney for Applicants

Johnson & Johnson
One Johnson & Johnson Plaza
New Brunswick, NJ 08933
Phone (513) 337-3535
Date: July 26, 2004



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Sheet 1 of 5

| | |
|-------------------------------|---------------------------|
| Application Number | 09/954,646 |
| Filing Date | September 18, 2001 |
| First Named Inventor | Foerster, Seth A., et al. |
| Group Art Unit | 3737 |
| Examiner Name | Eleri Mantis Mercader |
| Attorney Docket Number | END-777 |

U.S. PATENT DOCUMENTS

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|----------------------|--------------------------|-------------------------|---------------------|------------------------|--|--|--|----------------|
| | | Office ³ | Number ⁴ | Kind Code ⁵ | | | | |
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| INFORMATION DISCLOSURE STATEMENT BY APPLICANT (use as many sheets as necessary) Sheet 2 of 5 | Application Number | 09/954,846 |
| | Filing Date | September 18, 2001 |
| | First Named Inventor | Foerster, Seth A., et al. |
| | Group Art Unit | 3737 |
| | Examiner Name | Eleni Mantis Mercader |
| | Attorney Docket Number | END-777 |

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| Attorney Docket Number | END-777 |

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Approved for use through 10/31/2002. OMB 0651-0031

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**INFORMATION DISCLOSURE
STATEMENT BY APPLICANT**

(see as many sheets as necessary)

Sheet 4 of 5

| | |
|------------------------|---------------------------|
| Application Number | 09/854,848 |
| Filing Date | September 18, 2001 |
| First Named Inventor | Foerster, Seth A., et al. |
| Group Art Unit | 3737 |
| Examiner Name | Eleni Mantis Mercader |
| Attorney Docket Number | END-777 |

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| Examiner Initials | Cite No. | U.S. Patent Document | | Name of Patentee or Applicant of Cited Document | Date of Publication of Cited Document mm-dd-yyyy | Pages, Columns, Lines, where relevant passages or relevant figures appear |
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Patent
Attorney Docket No. 032,290-109
(formerly END-777)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of:

Foerster

Serial No.: 09/954,646

Filed: September 18, 2001

**For: METHODS AND DEVICES FOR
DEFINING AND MARKING TISSUE**

Group Art Unit: 3737

Examiner: Eleni M. Mantis Mercader

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SUPPLEMENTAL INFORMATION DISCLOSURE STATEMENT

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In accordance with 37 CFR §§ 1.97 and 1.98, the items identified in this Information Disclosure Statement ("IDS") are brought to the attention of the Office. The items are listed on the attached form PTO-SB/08a and PTO-SB/08b. In accordance with §1.98(d), copies of some or all of the references listed on the attached Form PTO-SB/08a and PTO-SB/08b are not enclosed herewith because they were previously cited by or submitted to the Patent and Trademark Office in one or more of the prior U.S. Applications: U.S. Application No. 08/308,097, filed on September 16, 1994, now abandoned; U.S. Application No. 08/858,389 filed on May 19, 1997, issued as U.S. Patent No. 6,228,055; U.S. Application No. 09/776,125, filed on February 2, 2001; U.S. Application No. 10/213,638, filed August 7, 2002; U.S. Application No. 10/966,551, filed on October 15, 2004; U.S. Application No. 10/734,671, filed December 12, 2003; and U.S. Application No. 10/630,883, filed on July 30, 2003. Copies of the references can be provided at the request of the Examiner.

The items identified in this IDS may or may not be "material" pursuant to 37 CFR § 1.56. The submission thereof by Applicant is not to be construed as an admission that any such patent, publication or other information referred to therein is material or considered to be material (37 CFR

CERTIFICATE OF MAILING (37 C.F.R. §1.8a)

I hereby certify that this paper (along with any referred to as being attached or enclosed) is being deposited with the United States Postal Service on the date shown below with sufficient postage as First Class Mail in an envelope addressed to the Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

September 30, 2005
Date of Deposit

Cynthia B. Pacheco
Cynthia B. Pacheco

10/05/2005 NBI 664835 1
10/05/2005 TELETYPE 00000010 502862 09954646
01 FC:1806 180.00 DA

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§ 1.97(h)), or even qualifies as "prior art" under 35 USC § 102 with respect to this invention unless specifically designated by Applicant as such.

INFORMATION DISCLOSURE STATEMENT FILING PROVISION:

☐ This IDS is believed to be timely in that it is being submitted under 37 CFR § 1.97(b), that is (1) within three months of the filing date of the application, which is not a continued prosecution application filed under § 1.53(d); or (2) within three months of entry of the national stage as set forth in 37 CFR § 1.491; or (3) before the mailing of a first Office action on the merits; or (4) before the mailing of a first Office action after filing a request for continued examination under § 1.114. Thus, no fee is required.

☐ However, if the undersigned is in error in this regard, Applicant respectfully requests that the Office consider this IDS as filed under 37 CFR § 1.97(c), if applicable, and charge the fee due under 37 CFR § 1.17(p) to the deposit account referenced below.

☐ However, if the undersigned is in error in this regard, Applicant respectfully requests that the Office consider this IDS as filed under 37 CFR § 1.97(c), if applicable, and a statement under 37 CFR § 1.97(e) is included below, thus no fee is required.

☒ This IDS is being submitted under 37 CFR § 1.97(c), that is after mailing of a first Office action on the merits, but before a Final Action under 37 CFR § 1.113 or a Notice of Allowance under 37 CFR § 1.311.

☒ The fee due under 37 CFR § 1.17(p) is submitted herewith.

☐ A statement under 37 CFR § 1.97(e) is included below, thus no fee is required. In the event that this IDS is not received before a Final Action or a Notice of Allowance, then Applicant respectfully requests that the Office consider the filing of these papers to be submitted under 37 CFR § 1.97(d) and charge the fee due under 37 CFR § 1.17(p) to the deposit account below.

☐ This IDS is being submitted under 37 CFR § 1.97(d), that is after a Final Action under 37 CFR § 1.113 or a Notice of Allowance under 37 CFR § 1.311, but before payment of the issue fee. A statement under 37 CFR § 1.97(e) is included below. The fee due under 37 CFR § 1.17(p) is submitted herewith.

Statement Under 37 CFR § 1.97(e):

☐ Each item contained in this IDS was first cited in a communication from a foreign patent office in a counterpart foreign application not more than three months prior to the filing of this IDS.

☐ No item contained in this IDS was cited in a communication from a foreign patent office in a counterpart foreign application, and, to the knowledge of the person signing this statement after

making reasonable inquiry, no item of information contained in this IDS was known to any individual designated in 37 CFR § 1.56(c) more than three months prior to the filing of this IDS.

PAYMENT AND/OR AUTHORIZATION TO CHARGE FEES:

- ☐ A check in the amount of \$180.00 is enclosed for the above fee(s).
☒ Please charge \$180.00 to Deposit Account No. 50-2862 for the above fee(s).

The Commissioner is authorized to charge any fees required by the filing of these papers, and to credit any overpayment to O'Melveny and Myers' Deposit Account No. 50-2862.

Respectfully submitted,

O'MELVENY & MYERS LLP

Dated: September 30, 2005

By: Diane K. Wong
Diane K. Wong
Reg. No. 54,550
Attorneys for Applicant

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**INFORMATION DISCLOSURE
STATEMENT BY APPLICANT**

(Use as many sheets as necessary)

Sheet

1

of

2

Complete if Known

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|----------------------|--------------------------------|
| Application No. | 09/954,648 |
| Filing Date | 9/18/2001 |
| First Named Inventor | Foerster |
| Art Unit | 3737 |
| Examiner Name | Eleni M. Mantis Mercader |
| Attorney Docket No. | 032,290-109 (formerly END-777) |

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| Examiner Initials | Cite No. ¹ | Document No. | Publication Date MM-DD-YYYY | Name of Patentee or Applicant of Cited Document | Pages, Columns, Lines, Where Relevant Passages or Relevant Figures Appear |
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|--------------------|-----------------------|--|--------------------------------|--|--|----------------|
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|-------|---|----|---|---------------------|--------------------------------|
| Sheet | 2 | of | 2 | Attorney Docket No. | 032,290-109 (formerly END-777) |
|-------|---|----|---|---------------------|--------------------------------|

Complete if Known

| | |
|----------------------|--------------------------|
| Application No. | 09/954,648 |
| Filing Date | 9/18/2001 |
| First Named Inventor | Foerster |
| Art Unit | 3737 |
| Examiner Name | Eleni M. Mantis Mercader |

FOREIGN PATENT DOCUMENTS

| Examiner Initials* | Cite No. ¹ | Foreign Patent Document Country Code ³ Number ⁴ Kind Code (if known) | Publication Date MM-DD-YYYY | Name of Patentee or Applicant of Cited Document | Pages, Columns, Lines, Where Relevant Passages or Relevant Figures Appear | T ² |
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NON PATENT LITERATURE DOCUMENTS

| Examiner Initials* | Cite No. ¹ | Include name of the author (in CAPITAL LETTERS), title of the article (when appropriate), title of the item (book, magazine, journal, serial, symposium, catalog, etc.), date, page(s) volume-issue number(s), publisher, city and/or country where published | T ² |
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Examiner
SignatureDate
Considered

*Examiner: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant. 1 Applicant's unique citation designation number (optional). 2 See Kinds Codes of USPTO Patent Documents at www.uspto.gov or MPEP 901.04. 3 Enter Office that issued the document, by the two-letter code (WIPO Standard ST.3). 4 For Japanese patent documents, the indication of the year of the reign of the Emperor must precede the serial number of the patent document. 5 Kind of document by the appropriate symbols as indicated on the document under WIPO Standard ST.16 if possible. 6 Applicant is to place a check mark here if English language Translation is attached.

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Département à
La Haye
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recherche

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London WC1V 7LE
GRANDE BRETAGNE

Datum/Date

05.12.03

Zeichen/Ref./Réf.

PAC/ags/18198A

Anmeldung Nr./Application No./Demande n°/Patent Nr./Patent No./Brevet n°.

03075084.8-1265-

Anmelder/Applicant/Demandeur/Patentinhaber/Proprietor/Titulaire

ETHICON ENDO-SURGERY, INC.

COMMUNICATION

The European Patent Office herewith transmits as an enclosure the European search report for the above-mentioned European patent application.

If applicable, copies of the documents cited in the European search report are attached.

☐ Additional set(s) of copies of the documents cited in the European search report is (are) enclosed as well.

The following specifications given by the applicant have been approved by the Search Division:

☐ abstract

☐ title

☒ The abstract was modified by the Search Division and the definitive text is attached to this communication.

The following figure will be published together with the abstract: 18, 19, 20.

REFUND OF THE SEARCH FEE

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| Place of search THE HAGUE | | Date of completion of the search 19 November 2003 | Examiner Barton, S |
| CATEGORY OF CITED DOCUMENTS X : particularly relevant if taken alone Y : particularly relevant if combined with another document of the same category A : technological background O : non-written disclosure P : intermediate document T : theory or principle underlying the invention E : earlier patent document, but published on, or after the filing date D : document cited in the application L : document cited for other reasons & : member of the same patent family, corresponding document | | | |

**ANNEX TO THE EUROPEAN SEARCH REPORT
ON EUROPEAN PATENT APPLICATION NO.**

EP 03 07 5084

This annex lists the patent family members relating to the patent documents cited in the above-mentioned European search report.
The members are as contained in the European Patent Office EDP file on
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**ANNEX TO THE EUROPEAN SEARCH REPORT
ON EUROPEAN PATENT APPLICATION NO.**

EP 03 07 5084

This annex lists the patent family members relating to the patent documents cited in the above-mentioned European search report.
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19-11-2003

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European Patent
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SUPPLEMENTARY

PARTIAL EUROPEAN SEARCH REPORT

Application Number

which under Rule 45 of the European Patent Convention EP 99 93 5335 shall be considered, for the purposes of subsequent proceedings, as the European search report

DOCUMENTS CONSIDERED TO BE RELEVANT

| Category | Citation of document with indication, where appropriate, of relevant passages | Relevant to claim | CLASSIFICATION OF THE APPLICATION (Int.Cl.8) |
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The supplementary search report has been based on the last set of claims valid and available at the start of the search.

INCOMPLETE SEARCH

The Search Division considers that the present application, or some or all of its claims, does/do not comply with the EPC to such an extent that a meaningful search into the state of the art cannot be carried out, or can only be carried out partially, for the following claims:

Claims searched completely :

Claims searched incompletely :

Claims not searched :

Reason for the limitation of the search:

see sheet C

1

EP0 FORM 1503 01.02 (94/C28)

| Place of search | Date of completion of the search | Examiner |
|--|----------------------------------|--------------------|
| The Hague | 27 October 2005 | Mayer-Martenson, E |
| CATEGORY OF CITED DOCUMENTS | | |
| X : particularly relevant if taken alone Y : particularly relevant if combined with another document of the same category A : technological background O : non-written disclosure P : intermediate document | | |
| T : theory or principle underlying the invention E : earlier patent document, but published on, or after the filing date D : document cited in the application L : document cited for other reasons & : member of the same patent family, corresponding document | | |

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ANNEX TO THE EUROPEAN SEARCH REPORT ON EUROPEAN PATENT APPLICATION NO.

EP 99 93 5335

This annex lists the patent family members relating to the patent documents cited in the above-mentioned European search report. The members are as contained in the European Patent Office EDP file on
The European Patent Office is in no way liable for these particulars which are merely given for the purpose of information.

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For more details about this annex : see Official Journal of the European Patent Office, No. 12/82



European Patent
Office

**LACK OF UNITY OF INVENTION
SHEET B**

Application Number

EP 99 93 5335

The Search Division considers that the present European patent application does not comply with the requirements of unity of invention and relates to several inventions or groups of inventions, namely:

1. claims: 1-13

biopsy localisation device with bioabsorbable element being palpable

2. claims: 14-16

biopsy localisation device with bioabsorbable element having roughened margins
